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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,569	07/18/2003	Carlos Nagib Khalil	Q76639	2109

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT PAPER NUMBER

1714

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/621,569

Applicant(s)

KHALIL ET AL.

Examiner

Shruti S. Costales

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,9,10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9,10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. All outstanding objections and rejections except for those described below are overcome by applicant's amendment filed September 26, 2005.
2. It is noted that applicant has amended the claims to add limitations that were not before the Examiner previously, therein necessitating new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

### ***Specification***

3. The amendment filed September 26, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

(i) The paragraph beginning at line 9 on page 6 of the specification introduces new matter at the second line of the replacement paragraph, wherein "ethanol" has been replaced with "alcohol". Further, in the same replacement paragraph a new sentence has been added "The neutralized ester corresponds to biodiesel fuel", wherein said sentence is not supported by the original disclosure.

(ii) The paragraph beginning at line 19 on page 6 of the specification introduces new matter at the fourth line of the replacement paragraph, wherein "lower than 20 mm" has been replaced with "up to 20 mesh Tyler". Further, in the same replacement paragraph the word "fine" has been added to modify the previously existing "fraction".

Moreover, "ethanol" has been replaced with "alcohol" at line 7 of the replacement paragraph.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The disclosure is objected to because the applicant has added the word "distillating", which appears to misspelled and should probably be replaced with "distilling".

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
6. Claims 1, 2, 4, 6, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stidham et al. (U.S. Patent Number 6,127,560) in view of Bradin (U.S. Patent Number 5,578,090, cited on PTO-1449 dated October 23, 2003), Drouillard et al. (U.S. Patent Number 6,506,423), and Saam (U.S. Patent Number 5,750,751).

The rejection is adequately set forth in paragraph 10 of the office action mailed June 27, 2005 and is herein incorporated by reference.

7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stidham in view of Bradin, Drouillard, Saam, and further in view of Lidgren (US Pre-Grant Publication Number 2003/0161858).

The rejection is adequately set forth in paragraph 11 of the office action mailed June 27, 2005 and is herein incorporated by reference.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stidham in view of Bradin, Drouillard, Saam, and further in view of Thames et al. (U.S. Patent Number 6,897,255).

The rejection is adequately set forth in paragraph 12 of the office action mailed June 27, 2005 and is herein incorporated by reference.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stidham in view of Bradin, Drouillard, Saam, further in view of Buchanan, and further in view of Anderson (U.S. Patent Number 5,710,030).

The rejection is adequately set forth in paragraph 14 of the office action mailed June 27, 2005 and is herein incorporated by reference.

### ***Response to Arguments***

10. Applicant's arguments filed September 26, 2005 have been fully considered but they are not persuasive. Specifically, applicant argues that (i) the present invention is different from Stidham because in the present invention seeds are fed directly into a reactor where they are mixed with anhydrous alcohol and catalyst for transesterification thus avoiding an oil extraction step, wherein the applicant cites the relevant portion of

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the specification for supporting said difference between the present invention and Stidham, and (ii) the secondary references do not cure the deficiencies of Stidham.

With respect to the argument in (i), the presently pending claims do not recite the alleged patentably distinguishable feature over Stidham. Moreover, the presently pending claims utilize "comprises" as the transitional phrase, wherein said transitional phrase is open-ended (See M.P.E.P. § 2111.03) therein not excluding feeding seeds directly into a reactor where they are mixed with anhydrous alcohol and catalyst for transesterification thus avoiding an oil extraction step. For example, applicant's claim 1 is not limited in scope to the mixing of the disclosed components in one order because of the transitional phrase "comprising", which is open-ended. See M.P.E.P. § 2111.03. Further, the transitional term "comprising is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) and *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997).

With respect to the argument in (ii), Bradin, Drouillard, Saam, Lidgren, Thames, Buchanan, and Anderson are used as teaching references, and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) and *In re Keller*, 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather Bradin teaches a certain concept, namely, to use substantially anhydrous alcohol in Stidham's process because saponification or hydrolysis of the triglycerides may be avoided, Drouillard

teaches a certain concept, namely, to use Stidham's cake removed in step 12 of FIG. 1 as animal feed because soybean meal is a source of proteins and carbohydrates and is suitable for livestock, Saam teaches a certain concept, namely, any precipitated solids during a transesterification reaction are removed by filtration and centrifugation after the reaction is complete, Lidgren teaches a certain concept, namely, to use the various oils obtained from the listed oil seeds of Lidgren in Stidham's process because these oils have similar desirable properties such as biological compatibility, unctuous viscous liquid or solid easily liquefiable on warming, immiscible with water, and pharmacologically inert, Thames teaches a certain concept, namely, to use the catalysts of Thames in Stidham's process because sodium and potassium acetate are particularly suitable in transesterification type reactions, Anderson teaches a certain concept, namely, to use the ethanol produced by fermentation as disclosed by Anderson in Stidham's process because the ethanol so produced may be used for transesterification process as one integrated process, and in combination with the primary reference, discloses the presently claimed invention.

### ***Conclusion***

11 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shruti S. Costales whose telephone number is (571) 272-8389. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSC  
Shruti S. Costales  
January 6, 2005

*Vasu Jagannathan*  
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